

REMARKS

Applicants appreciate the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the present application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

In order to render the claims more clear and definite, and to emphasize the patentable novelty thereof, claims 1, 4-5, 8, 11, 15-16, 27, 35-38, and 41 have been amended, and claims 10, 26, 39, and 40 been cancelled without prejudice. Accordingly, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

Rejections

Rejection Under 35USC Section 102

Claims 1-25 have been rejected under 35 USC Section 102(e), as being anticipated by U.S. published patent application 2002/0097452 to Nagarajan ("Nagarajan"). Applicants respectfully traverse the rejection and request reconsideration based on the amendment to claims 1, 4-5, 8, 11, and 15-16, and features in the other claims which are neither disclosed nor suggested in the cited reference.

As to a rejection under 102, "[a]nticipation is established only when a single prior art reference discloses expressly or under the principles of inherence, each and every element of the claimed invention." *RCA Corp. v. Applied Digital Data Systems, Inc.*, (1984, CAFC) 221 U.S.P.Q. 385. The standard for lack of novelty, that is for "anticipation," is one of strict identity. To anticipate a claim, a patent or a single prior art reference must contain all of the essential elements of the particular claims. *Schroeder v. Owens-Corning Fiberglass Corp.*, 514 F.2d 901,

185 U.S.P.Q. 723 (9th Cir. 1975); and Cool-Fin Elecs. Corp. v. International Elec. Research Corp., 491 F.2d 660, 180 U.S.P.Q. 481 (9th Cir. 1974). The identical invention must be shown in as complete detail as is contained in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Independent claim 1 (amended), and its dependent claims 2-9, are patentably distinguishable over the cited reference because claim 1 emphasizes the novel features of the present invention in which, without user intervention, a target item is optically scanned using predefined settings for scanning parameters and converted into a data file. In this regard, claim 1 recites:

“1. (Currently amended) A method of optically scanning a target item, comprising: configuring an optical scanning arrangement with predefined settings for scanning parameters appropriate to a photographic image;
 initiating a scanning operation;
 in response to the initiating, optically scanning the target item using the predefined settings to form a digital image of the target item; and
 converting the digital image into a data file, wherein the scanning and the converting are performed automatically without intervention by a user, and wherein the predefined settings are not defined by the user.” (emphasis added)

The Nagarajan reference discloses that a “scanning system ... provides recommended settings for image mode and image parameters to assist the user in adjusting the settings (Abstract; emphasis added). “Although prior art scanners can save manually inputted default settings, there is a need for a dynamic user interface to adjust the image parameters of the digital scanner to meet various customer requirements” (paragraph [0004], lines 18-21; emphasis added). As is described in the Nagarajan reference in detail:

“In accordance with this invention an image data analyzer 160 is connected to receive the full page video histogram of the scanned image as well as the pixel tag histogram obtained from the segmentation module 152. The full page image data provides data which assists in the classification of the image into a particular mode. The pixel tag histogram contains information with respect to the pixel type, (i.e. one of the 32 classes of pixels). This data assists in the

analysis of individual image parameter. As previously indicated, in general, the available mode selection includes: general use default mode, text mode, coarse halftone mode, high frequency halftone mode, photograph mode, laser print/newspaper mode (coarse halftone and text), magazine mode (high frequency halftone and text), and photographic and text mode. The parameters that are typically set or adjusted include: auto-background suppression level, lighter/darker and contrast setting, tonal reproduction curve, filter level (sharpness/descreen level), and rendering method.

Image data analyzer 160 includes a full page video image module 161 which operates to generate a histogram representing said video data. Further data based on the full page histogram is collected in video statistic module 162. As another part of the image data analyzer 160, a pixel tag histogram is generated in pixel tag module 163 and data based on the pixel tag histogram is collected in pixel tag statistic module 164. The processed image data from each source is combined and further processed in data analyzer 165 to determine optimum settings for both mode and specific parameters. The optimum settings are then compared to the current settings, in the scanning assist module 166, to generate recommended adjustments. The adjustment data may be stored in SRAM 140 and communicated to the user through the scanner interface 40 which may include workstation 50. By operating through the scanner interface, the user has the option to select the optimum settings." (paragraph [0020], line 1 – paragraph [0021], line 17; emphasis added)

Significantly, the Nagarajan reference does not disclose configuring the optical scanning arrangement with predefined settings for scanning parameters appropriate to a photographic image, optically scanning the target item using the predefined settings to form a digital image, and converting the digital image into a data file. Rather, it performs a full page image scan and then analyzes that scan in order to determine the optimum settings for the scanning parameters.

Furthermore, the Nagarajan reference does not disclose that the scanning and the converting are performed automatically without intervention by a user, and that the predefined settings are not defined by the user. On the contrary, it discloses that adjustment data for the scanning parameters is communicated to the user through the scanner interface, and that the user intervenes by deciding whether or not to select the optimum settings recommended by the system.

The Office (Office Action, p.4, re claim 10) cites paragraph [0018], lines 8-14 of the Nagarajan reference as disclosing that the scanning and converting is performed without any further user intervention. The cited paragraph discloses:

“In this manner computing unit 110 controls the overall functioning of the system 30 and the flow of image data through the various components. Although individual modules are shown for illustrative purposes, it should be noted that in some instances the modules may form part of a larger microprocessor without altering their function.”

Applicants do not understand how this paragraph discloses a lack of user intervention. When considered in light of paragraphs [0004], [0020], and [0021] cited above by Applicants, the Office’s interpretation is clearly incorrect.

The novel features of the present invention are not anticipated by the Nagarajan reference in that the essential elements of configuring an optical scanning arrangement with predefined settings for scanning parameters appropriate to a photographic image which are not defined by a user, and optically scanning a target item using the predefined settings to form a digital image and converting the digital image into a data file automatically and without intervention by a user, are absent from the Nagarajan reference. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Independent claim 11 (amended), and its dependent claims 12-25, are patentably distinguishable over the cited reference because claim 11 emphasizes the novel features of the present invention in which a digital image acquired from an image source is stored in a file system folder having a folder name indicative of a date automatically associated with the digital image. In this regard, claim 11 recites:

“11. (Currently amended) A method of automatically organizing digital images, comprising:
acquiring a digital image from an image source;
automatically associating a date with the digital image;
automatically converting the digital image into a data file; and
storing the data file into a folder of a file system, the folder having a folder name indicative of the date.”

The Nagarajan reference is silent as to storing the data file into a folder of a file system, where the folder has a folder name indicative of a date associated with the digital image. With regard to the limitation of automatically associating a date with the digital image, the Office

states that “PC 50 of fig. 1, inherit associate a data with digital image read by digital scanner 30” (Office Action, p.5, regarding claim 11). Even assuming that what the Office meant to say is that PC 50 inherently associates a date with the digital image read by digital scanner 30, the Nagarajan reference still does not disclose that the data file is stored in a folder having a folder name indicative of the date. With regard to this feature, the present application, with reference to Figs. 3 and 4, discloses:

“At 108, the data file is stored into a data folder, such as folder 42, of a file system 40. The folder 42 is associated with the date, and typically selected from a set of data folders. If no folder 42 associated with the date as yet exists on the file system 40, such a folder 42 is created. In the preferred embodiment, the data folder is associated with a particular month and year, such as folder 42a for July 2001 and folder 42b for August 2001. For example, for a particular digital image that has a capture date of Jul. 15, 2001 and a storage date of Aug. 23, 2001, if the associated date is the capture date, the image file will be stored into the July 2001 folder 42a, alternatively, if the associated date is the storage date, the image file will be stored into the August 2001 folder 42b. Such a folder organization advantageously organizes the digital images by date, thus helping the user to easily and quickly locate desired images for viewing or post-processing.”

The novel features of the present invention are not anticipated by the Nagarajan reference in that the essential element of storing the data file into a folder of a file system, the folder having a folder name indicative of a date associated with the digital image, is absent from the Nagarajan reference, which is silent as to folder names. Therefore, the rejection is improper at least for this reason and should be withdrawn.

Rejection Under 35USC Section 103

Claims 27-38, and 41 have been rejected under 35 USC Section 103(a), as being unpatentable over U.S. published patent application 2002/0097452 to Nagarajan ("Nagarajan") in view of U.S. patent 6,940,526 to Noda et al. ("Noda"). Applicants respectfully traverse the rejection and request reconsideration based on the amendment to claims 27, 35-38, and 41, and features in the claims which are neither disclosed nor suggested in the cited references, taken either alone or in combination.

Applicants note that there appears to be no discussion of the Noda reference in the Office Action except with regard to claim 26 (now canceled).

As to a rejection under 103(a), the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant’s disclosure.

In the present case, the Office has not established a *prima facie* case of obviousness because the applied references do not teach or suggest all of Applicant’s claim limitations.

Independent claim 27 (amended), and its dependent claims 28-34, are patentably distinguishable over the cited references because claim 27 emphasizes the novel features of the present invention in which a digital image acquired from an image source is stored in a file system folder having a folder name indicative of a date automatically associated with the digital image. In this regard, claim 27 recites:

“27. (Currently amended) An image processing system, comprising:
at least one image source, each image source for providing at least one digital image upon request;
an image capture subsystem coupled to the at least one image source for requesting and receiving the at least one digital image from the at least one image source, the image capture

subsystem further for associating a date with each digital image and automatically converting each digital image into a corresponding image file; and

a file system coupled to the image capture subsystem for automatically storing each image file in a selected one of a plurality of data folders, the selected data folder having a folder name indicative of the date.” (emphasis added)

As explained heretofore with reference to claim 11, the Nagarajan reference is silent as to storing an image file in a data folder having a folder name indicative of a date that is associated with the digital image.

The Office does not contend that the Noda reference teaches or suggests such a feature, and Applicants do not find such a feature in the Noda reference.

Applicants respectfully traverse the Office’s assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the claimed features of Applicants’ invention. Such could be possible only in hindsight and in light of Applicants’ teachings. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Independent claims 35, 37, and 41 (all currently amended) each recite limitations similar to those of claim 27, discussed above.

Claim 35 recites:

“35. (Currently amended) A processor-readable medium having processor-executable instructions thereon which, when executed by a processor, cause the processor to:
acquire a digital image from an image source;
automatically convert the digital image into a data file having a date associated with the digital image; and
store the data file into a data folder of a file system, the folder having a folder name indicative of the date.”

Claim 37 recites:

“37. (Currently amended) An image processing system, comprising:
means for acquiring a digital image from an image source;
means for automatically converting the digital image into a data file having a date associated with the digital image; and

means for storing the data file into a data folder of a file system, the folder having a folder name indicative of the date.”

Claim 41 recites:

“41. (Currently amended) An image processing system, comprising:
at least one image source, each image source for providing at least one digital image upon request;

an image capture subsystem coupled to the at least one image source which requests and receives the at least one digital image from the at least one image source, associates a date with each image, and automatically converts each image into a corresponding image file; and

a file system coupled to the image capture subsystem which receives each image file from the image capture subsystem and automatically stores each image file in a selected one of a plurality of data folders, the selected data folder having a folder name indicative of the date.”

For similar reasons as explained heretofore with regard to claim 27, the features of the present invention are not taught or suggested by the cited references in that the features of storing the image file or data file into a data folder of a file system, the folder having a folder name indicative of a date associated with the digital image are neither taught nor suggested by the Nagarajan reference in combination with the Noda reference.

Applicants respectfully traverse the Office’s assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the claimed features of Applicants’ invention. Such could be possible only in hindsight and in light of Applicants’ teachings. Therefore, the rejection of independent claims 35, 37, and 41 is improper at least for that reason and should be withdrawn.

Independent claim 36 (amended) is patentably distinguishable over the cited references because claim 36 emphasizes the novel features of the present invention in which, without user intervention, a target item is optically scanned using predefined settings for scanning parameters and converted into a data file. In this regard, claim 36 recites:

“36. (Currently amended) A processor-readable medium having processor-executable instructions thereon which, when executed by a processor, cause the processor to:
configure an optical scanning arrangement with predefined settings for scanning parameters appropriate to a photographic image;

detect an initiation of a scanning operation;
in response to the initiation, optically scan the target item using the predefined settings to form a digital image of the target item; and
convert the digital image into a data file, wherein the instructions to scan and convert are performed automatically after the initiation without intervention by a user, and wherein the predefined settings are not defined by the user.” (emphasis added)

As explained heretofore with reference to claim 1, the Nagarajan reference does not teach or suggest a processor-readable medium having instructions to configure an optical scanning arrangement with predefined settings for scanning parameters appropriate to a photographic image which are not defined by a user, and to optically scan a target item using the predefined settings to form a digital image and convert the digital image into a data file automatically and without intervention by a user.

The Office does not contend that the Noda reference teaches or suggests such features, and Applicants do not find such a feature in the Noda reference.

Applicants respectfully traverse the Office’s assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the claimed features of Applicants’ invention. Such could be possible only in hindsight and in light of Applicants’ teachings. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Independent claim 38 (currently amended) recites limitations similar to those of claim 36, discussed above.

Claim 38 recites:

“38. (Currently amended) An image processing system, comprising:
means for configuring an optical scanning arrangement with predefined settings for scanning parameters appropriate to a photographic image;
means for initiating a scanning operation;
means for optically scanning the target item using the predefined settings to form a digital image of the target item; and

means for converting the digital image into a data file, wherein the scanning and the converting are performed automatically without intervention by a user, and wherein the predefined settings are not defined by the user.”

For similar reasons as explained heretofore with regard to claim 36, the features of the present invention are not taught or suggested by the cited references in that the features of means for configuring an optical scanning arrangement with predefined settings for scanning parameters appropriate to a photographic image which are not defined by a user, and means for optically scanning a target item using the predefined settings to form a digital image and for converting the digital image into a data file automatically and without intervention by a user, are neither taught nor suggested by the Nagarajan reference in combination with the Noda reference.

Applicants respectfully traverse the Office’s assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the claimed features of Applicants’ invention. Such could be possible only in hindsight and in light of Applicants’ teachings. Therefore, the rejection of independent claim 38 is improper at least for that reason and should be withdrawn.

Formalities

Status of the Drawings

The "Office Action Summary" of the present office action indicates that the drawings filed on 8/29/2001 are objected to by the Examiner. However, there is no description of this objection in the detailed action. Furthermore, while the drawings filed on 8/29/2001 were informals, Public PAIR records that formal drawings were filed on 1/7/2002 (the PAIR mail room date shows 2/12/2002). Accordingly, Applicants believe that the present drawings are in compliance with all applicable requirements.

Conclusion

Attorney for Applicant(s) has carefully reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.

**AUTHORIZATION TO PAY AND PETITION
FOR THE ACCEPTANCE OF ANY NECESSARY FEES**

If any charges or fees must be paid in connection with the foregoing communication (including but not limited to the payment of an extension fee or issue fees), or if any overpayment is to be refunded in connection with the above-identified application, any such charges or fees, or any such overpayment, may be respectively paid out of, or into, the Deposit Account No. 08-2025 of Hewlett-Packard Company. If any such payment also requires Petition or Extension Request, please construe this authorization to pay as the necessary Petition or Request which is required to accompany the payment.

Respectfully submitted,



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